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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,405	07/30/2001	Jochen Heinz	5083-25	4667

7590 08/28/2002

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EXAMINER

ASSADI, KATHRYN L

ART UNIT	PAPER NUMBER
3763	

3763

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/918,405	Applicant(s)	HEINZ ET AL.
Examiner	Kathryn L Assadi	Art Unit	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 07/22/02.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-15 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 30 July 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 9-12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeirney et al (WO 88/09679). McNeirney et al discloses a metering receptacle comprising an elongate hollow body having a first end with a closable exit opening and a second end; a plunger stopper that is accommodated in the hollow body in a longitudinally displaceable manner so as to close the second end of the hollow body; a plunger rod attached to the stopper, the plunger stopper including a sealing stopper part positioned rigidly in the elongate hollow body and having a centric through-bore for the passage of the plunger rod; and a longitudinally displaceable plunger part of lubricious plastic connected to the plunger rod so that the displaceable plunger part is movable away from the sealing stopper part when the plunger rod is moved through the through-bore (Figure 1) (Detailed Descriptions, first paragraph).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNeirney et al in view of Sams (US 5,743,889). McNeirney et al teaches all of the limitations of the claims except for disclosing a metering receptacle wherein the plunger part is releasably connected to the plunger rod by a screw connection. Sams discloses a syringe similar to the syringe of Szwarc wherein the plunger part is releasably connected to the plunger part by a screw connection (Abstract). It would have been obvious to one with ordinary skill in the art to use the teachings of Sams to modify the invention of McNeirney et al by connecting the plunger part to the plunger rod by a means such as a screw connection since a screw connection is notoriously well known as a means of connecting parts together. A possible advantage of having a screw connection could be in order to disassembly the metering receptacle for purposes of cleaning it.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNeirney et al in view of Thibault et al (US 5,607,400). McNeirney et al teaches all of the limitations of the claims except for a sliding layer, such as silicon deposited on the plunger rod. Thibault et al discloses that to facilitate sliding, a low friction material may be disposed on the stopper (Column 2, lines 60-62). It would have been obvious to one with ordinary skill in the art to use the teachings of Thibault et al to modify the invention of McNeirney et al to make a plunger rod with a sliding layer on the outer circumference. The low friction material that Thibault teaches can be a sliding layer that can be applied on the outer circumference of the plunger rod, since a layer that slides has low friction.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNeirney et al in view of Thibault. McNeirney et al and Thibault et al disclose all of the limitations of the claims except a sliding layer made of silicon. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make a sliding layer of silicon because Applicant has not disclosed that making a sliding layer of silicon provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the sliding layer taught by McNeirney et al and Thibault et al or the claimed silicon layer because both layers perform the same function of providing a low friction material that makes slidability easy. Therefore, it would have been an obvious matter of design choice to modify McNeirney et al and Thibault et al to obtain the invention as specified in claim 6.

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Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNeirney et al in view of Thibault as applied to claim 5 above, and further in view of Kolberg (US 6,053,895). McNeirney et al and Thibault teach all of the limitations of the claims except for a rod made of polytetrafluoroethylene (PTFE). Kolberg discloses a rod made of PTFE (See Abstract). It would be obvious to one with ordinary skill in the art to use the teachings of Kolberg to modify the invention of McNeirney et al and Thibault to create a rod made of PTFE since as Kolberg teaches, PTFE displays good sliding properties that would allow for the rod to slide through the hollow body easily.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNeirney et al in view of Hecker (US 6,309,374). McNeirney et al teaches all of the limitations of the claims except for a bleeding channel parallel to a longitudinal axis of the plunger rod. Hecker discloses a bleeding channel parallel to a longitudinal axis of the plunger rod. Hecker teaches a channel (22) that extends along a longitudinal axis through the needle guide platform. Even though the channel that Hecker discloses is used to dispose a needle which is axially movable along an axis of injection through the channel, it would have been obvious to one with ordinary skill in the art to use the teachings of Hecker to modify the invention of McNeirney et al to make a channel parallel to a longitudinal axis of the plunger rod that could be used as a means through which air may flow from the outside into the space between the plunger part and the rigidly positioned stopper part, so as to prevent the formation of a vacuum in the above-mentioned space.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn L Assadi whose telephone number is 703-305-3286. The examiner can normally be reached on 8:30 AM - 6:00 PM: 1st Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

KLA *KLA*  
August 25, 2002

*Michael J. Hayes*  
**MICHAEL J. HAYES**  
**PRIMARY EXAMINER**